



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/924,684	08/09/2001	Jonathan Turner	05793.3063	2377
22852 7590 02/25/2008 FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413				
			EXAMINER DUNHAM, JASON B	
			ART UNIT 3625	PAPER NUMBER
			MAIL DATE 02/25/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/924,684

Applicant(s)

TURNER ET AL.

Examiner

JASON B. DUNHAM

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11/28/07.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17, 37-55 and 75-91 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17, 37-55, and 75-91 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on November 28, 2007 has been entered. Applicant amended claims 1, 4-12, 15, 16, 37, 40-51, 53, 54, 75-86, 89, and 90 and canceled claims 36, 74, and 109. Claims 1-17, 37-55, and 75-91 are pending.

Regarding the amendments to claims 6-7, 12-13, 15, 42-43, 50-51, 53, 80-81, 86-87, and 89 the Examiner further notes the recited "if" do not move to distinguish the claimed invention from the cited art. These phrases are conditional limitations with the noted "if" step not necessarily performed. Accordingly, once the positively recited steps are satisfied, the method as a whole is satisfied -- regardless of whether or not other steps are conditionally invocable under certain other hypothetical scenarios. [See: In re Johnston, 77 USPQ2d 1788 (CA FC 2006); Intel Corp. v. Int'l Trade Comm'n, 20 USPQ2d 1161 (Fed. Cir. 1991); MPEP §2106 II C]. The examiner further recommends amending independent claims 1, 37, and 75 to more positively recite the user purchasing the item in the future, in lieu of "assuming the user purchases the item".

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-14, 17, 37-52, 55, 75-88, and 91 are rejected under 35 U.S.C. 102(e) as being anticipated by Lilly (US 2002/0156723).

Referring to claim 1. Lilly discloses a method for providing messages to a user located at a client system attached to a network while the client system is displaying a web page associated with a web site provided by a web server through the network, the method comprising:

- Obtaining a financial account limit and an outstanding balance of a financial account associated with the user (Lilly: figure 3a);
- Determining that the user is attempting to purchase an item from the web site using the financial account (Lilly: paragraph 78);
- Analyzing a cost of the item against the financial account limit associated with the financial account (Lilly: paragraph 89);
- Determining whether the sum of the cost of the item and the outstanding balance exceeds the financial account limit (Lilly: figure 5a and paragraphs 81-82); and

- Presenting a message for display along with the web page based on a determination that the sum of the cost of the item and the outstanding balance does not exceed the financial account limit, wherein the message includes an indication reflecting a new outstanding balance associated with the financial account assuming the user purchases the item from the web site using the financial account (Lilly: figure 5b, table I, and paragraphs 89-90).

Referring to claims 2-3. Lilly further disclose a method wherein determining that the user is attempting to purchase the item from the web comprises determining that the user has selected a trigger or an option that indicates or reflects that the user is attempting to purchase the item (Lilly: paragraph 78).

Referring to claim 4. Lilly further discloses a method comprising: presenting a message reflecting an offer to increase the financial account limit, based on a determination that the sum of the cost of the item and the outstanding balance exceeds the financial account limit (Lilly: figure 5b and paragraphs 81-82). The examiner submits that Lilly discloses querying a customer to extend their line of credit when their outstanding balance exceeds their general purpose line of credit.

Referring to claim 5. Lilly further discloses a method wherein obtaining a financial account limit and an outstanding balance of a financial account associated with the user comprises:

- Ranking the financial account based on a current status of the account (Lilly: paragraph 49);

- Presenting a message reflecting that the financial account limit will be exceeded, based on a determination that the sum of the cost of the item and the outstanding balance exceeds the financial account limit and based on the rank of the financial account (Lilly: paragraphs 41 and 49-50, targeting specific customers based on level of risk).

Referring to claim 6. Lilly further discloses a method comprising: if a determination is made that the sum of the cost of the item and the outstanding balance exceeds the financial account limit, presenting a message reflecting an indication that if the item is purchased using the financial account, the financial account limit will be exceeded (Lilly: figure 5b and paragraphs 81-82). Lilly allows a customer to access their extra credit lines if their general purpose line is exceeded.

Referring to claim 7. Claim 7 is rejected under the same rationale set forth above.

Referring to claim 8. Lilly further discloses a method wherein the steps of obtaining, determining that the user is attempting to purchase an item from the web site, analyzing, determining whether the sum of the cost of the item and the outstanding balance exceeds the financial account limit, and presenting, are each performed by an application located at the client system (Lilly: figure 5b and paragraphs 99-101).

Referring to claim 9. Lilly further discloses a method wherein the steps of obtaining a financial account limit and analyzing the outstanding balance are performed by a financial account issuer (Lilly: paragraph 39).

Referring to claims 10-11. Claims 10-11 are rejected under the same rationale set forth above.

Referring to claim 12. Lilly further discloses a method wherein the message includes an indication reflecting a number of payments at a determined amount that, if the item is purchased with the financial account, the user would have to make to a financial account issuer (Lilly: paragraph 115).

Referring to claim 13. Lilly further discloses a method wherein the determined amount is selected by the user (Lilly: paragraph 125).

Referring to claim 14. Lilly further discloses a method wherein the message includes an indication reflecting a payment amount that the user would periodically have to make to a financial account issuer to pay off the purchase price of the item (Lilly: paragraph 126).

Referring to claim 17. Lilly further discloses a method including obtaining account information including interest rate (Lilly: paragraph 50).

Referring to claims 37-45. Claims 37-45 are rejected under the same rationale set forth above.

Referring to claims 46-47. Lilly further discloses a medium wherein the client system executes a browser for rendering the web page that is displayed at the client system, and wherein the message is displayed on top of a browser window (Lilly: paragraphs 46 & 78). The examiner submits that it is old and well known in the art to display messages from web site by using scrolling messages and pop-up windows.

Referring to claims 48-52, 55, 75-88, and 91. Claims 48-55, 75-88, and 91 are rejected under the same rationale set forth above.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 15-16, 53-54, and 89-90 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lilly in view of Ehrlich (US 6,873,968).

Referring to claims 15-16, 53-43, and 89-90. Lilly disclose all of the above but does not expressly disclose a method, medium, or system comprising: if a determination is made that the sum of the cost of the item and the outstanding balance exceeds the financial account limit, presenting a message including: an indication that an item may be purchased at an alternate web site for an amount lower than that offered by the web site. Ehrlich discloses system, mediums and methods for relaying messages to users indicating that an item may be purchased at an alternate web site for an amount lower than that offered by the web site (Ehrlich: abstract and column 4, line 62 – column 5, line 19). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to have modified the method, medium and system of Lilly to have included a message indicates that an item may be purchased at an alternate web site for an amount lower than that offered by the web site, as taught by

Ehrlich, in order to allow the customer to receive the lowest price for items (Ehrlich: column 5, lines 37-46).

Response to Arguments

Applicant's arguments filed November 28, 2007 have been fully considered but they are not persuasive. Applicant argues that Lilly does not display an outstanding balance to a user assuming the user purchases an item and the outstanding balance does not exceed the financial account limit, as recited in claim 1. The examiner disagrees; figure 5a of Lilly discloses sending the authorization result to a customer if an attempt to purchase an item is successful and paragraph 61 disclosing displaying the new available balance in a notification message. Similar independent claims 37 and 75 as well as the dependent claims of claims 1, 37, and 75 are rejected under the same rationale.

Regarding applicant's to claims 5, 41, and 79, please see the examiner's notes above in the rejection of claim 5 where in Lilly ranks customers by targeting specific users based on their credit. Lastly, applicant argues that Lilly does not disclose a number of payments and payment amount that a user would have to make on a financial account based on the purchase price of the item (claims 12, 14, 50, 52, 86, and 88). The examiner disagrees, Lilly discloses a minimum payment (similar to applicant's paragraph 89 disclosure) and its due date based on the user's transactions (see at least paragraphs 116 and 125).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Perkes, Bard, and Golan (see pto-892).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JASON B. DUNHAM whose telephone number is (571)272-8109. The examiner can normally be reached on M-F, 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeff Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JBD
Patent Examiner
2/18/08

/Matthew S Gart/
Primary Examiner, Art Unit 3625